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Docket Number (Optional)

B-369

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on 2/08/2006
Signature Jerrine Hall

Typed or printed name Jerrine Hall

Application Number

10/803,518

Filed

March 17, 2004

First Named Inventor

Steven C. Taylor

Art Unit

2856

Examiner

**Jacques M.
Saint Surin**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 33,720

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Alan D. Kirsch
Signature

Alan D. Kirsch
Typed or printed name

208/526-1371
Telephone number

2/7/06
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Steven C. Taylor

Serial No.: 10/803,518

Filed: March 17, 2004

For: Ultrasonic Pulser-Receiver

Examiner: Jacques M. Saint-Surin

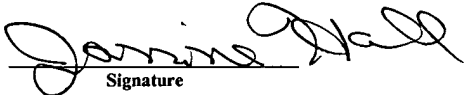
Group Art Unit: 2856

Attorney Docket No.: B-369

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Concurrent with the filing of a Notice of Appeal in connection with the above-identified application, the undersigned requests review of the Final Office Action dated December 22, 2005 (hereinafter "the Office Action") of the following issues.

Insufficient evidence has been presented to support motivation to combine the teachings of U.S. Patent No. 5,303,591 to Dykes et al. with U.S. Patent No. 6,570,097 to Monde et al. in the rejection of claims 1-30 and 44 and the obviousness rejections of these claims are improper for at least this reason.

The Dykes et al. reference fails to disclose a connector configured to couple the ultrasonic transducer directly to the circuit board, to the pulser circuitry and receiver circuitry, as required by claims 1-30 and 44. Because of this feature, impedance mismatches that would result if the transducer was coupled to the circuit board via a cable can be avoided, for the embodiments recited in claims 1-30 and 44.

It would not be obvious to combine the Monde et al. reference with the Dykes et al. reference. The mere fact that the structures of the references could possibly be somehow modified to result in the claimed structure does not render the claimed structure obvious unless the references themselves suggest the desirability of the modification. Monde et al. are not at all concerned with ultrasonic pulser-receiver circuitry. Indeed, Monde et al. state that “The connector of the present invention may be either of the type where it is mounted directly to a substrate or of the type where it is connected to a cable.” If one of ordinary skill in the art were to combine Monde et al. with Dykes et al., they might still use a cable, and thus not solve the problem solved by Appellant.

Nothing in Monde et al. suggests using the Monde et al. connector to couple an ultrasonic transducer to a circuit board. Monde et al. instead disclose that “The connector can be used for various applications such as interconnection between a plurality of circuit boards, interconnection between a plurality of devices, interconnection between connectors and circuit boards, interconnection between connectors, and integrated circuit sockets such as CPU sockets.” There is no disclosure of using the Monde et al. connector to connect an ultrasonic transducer to a circuit board or even a generic component to a circuit board.

The Federal Circuit discussed proper motivation in the case of *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action that “The Examiner believes that one of ordinary skill in the art would be motivated to recognize how to modify the teaching of

Dykes for utilizing the connector of Monde in which impedance matching can be easily established”, is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner’s conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The only rationale is the subjective opinion of the Examiner improperly based upon Appellant’s own disclosure. There is no motivation to combine the reference teachings, and the Office has failed to establish a *prima facie* rejection for at least this reason.

Further, even if the references could be combined, the combination would fail to provide all the elements of claim 1. Claim 1 recites that the connector is proximate an end of the circuit board.

Even if Monde et al. could be combined with Dykes et al, nothing in Monde et al. suggests where on a circuit board a connector should be located.

With regard to claim 44, even if Dykes et al. could be combined with Monde et al. and if that combination could be further combined with Landry et al., a combination of three references, the combination of references would still fail to disclose a front surface ring down of less than 60 nanoseconds.

With regard to the rejection of claims 1-12, 26-27, and 44, the Examiner has stated that discovering the optimum or workable ranges involves only routine skill in the art, and has cited *In re Aller*. The Examiner must show something in the references themselves that teaches or suggests Appellant's claimed combination of parameters. The following remarks by the Court of Customs and Patent Appeals are pertinent:

"The Solicitor, relying upon *In re Aller*, 42 C.C.P.A. 824, 220 F.2d 454, 105 U.S.P.O. [sic] 233 (CCPA 1955), argues that it is 'not unobvious to discover optimum or workable ranges by routine experimentation.' In many instances, this may be true. The problem, however, with such 'rules of patentability' (and the ever-lengthening list of exceptions which they engender) is that they tend to becloud the ultimate legal issue - obviousness - and exalt the formal exercise of squeezing new factual situations into preestablished pigeonholes. Additionally, the emphasis upon routine experimentation is contrary to the last sentence of section 103."

In re Yates, 663 F.2d 1054 (CCPA 1981).

Therefore, claims 1-30 and 44 are allowable.

Insufficient evidence has been presented to support motivation to combine the teachings of U.S. Patent No. 5,303,591 to Dykes et al. with U.S. Patent No. 3,201,612 to Amodei in the

rejection of claims 31-43 and the obviousness rejections of these claims are improper for at least this reason.

Further, if one of ordinary skill in the art were given Amodei and Dykes et al., they would not even realize that it is desirable to produce rise time of less than 1 nanosecond absent Appellant's disclosure. Amodei discloses a pulse generator and is not concerned with the field of ultrasonics or non-destructive testing.

Given only Amodei and Dykes et al., if it were possible to combine them, one of ordinary skill in the art would perhaps want to couple a tuning transmission line across a storage diode, as taught by Amodei. However, it would not be clear which of the diodes in Dykes et al. should have a tuning transmission line coupled across it or whether a new diode should be added. If a new diode should be added, it is not clear where it should be placed.


Even if the references were combined, the combination would fail to include an input configured to receive an input pulse from an external computer, as required by claim 31. The term "computer" does not appear anywhere in Dykes et al.

Therefore, claim 31 is allowable. As claims 32-43 depend on claim 31, they too are allowable.

In view of the foregoing, allowance of claims 1-44 is requested.

Respectfully submitted,

Dated: 2/7/06

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